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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,198	10/31/2001	Jeffrey Erdfarb	12186/1	4144

26304 7590 09/24/2007
KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585

EXAMINER

COHEN, AMY R

ART UNIT	PAPER NUMBER
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2859

MAIL DATE	DELIVERY MODE
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09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/003,198	ERDFARB, JEFFREY	
	Examiner	Art Unit	
	Amy R. Cohen	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE 8/24/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-18 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 13-18, 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook (U. S. Patent No. 6,237,243).

Cook teaches a tape measuring device (10) for determining a first distance, the first distance being related to a first dimension measured on a drawing depicting features at a first scaling ration, the measuring device comprising: a first set of indicia (22) comprising marks spaced at one inch intervals and located on a first side of a tape of the tape measuring device (Fig. 1, Col 3, lines 43-54); a second set of indicia (44, 46, 58, 60) comprising marks spaced at intervals correlating to the first scaling ratio and depicting a defined number of feet per inch, said second set of marks located on a second side of the tape (Figs. 3-5, Col 4, lines 4-40), wherein the first set of indicia and the second set of indicia start at a common end of the tape (Col 3, lines 55-60, the appliqué is positioned against or proximal to the end hook 24, which is a common end of the first set of indicia on surface 32), and wherein the second set of indicia include numerals shown next to each mark denoting the number of feet at the distance of each mark with respect to the first scaling ratio (Fig. 5).

Cook teaches the tape measuring device further adapted for laying out a second distance, wherein when the second distance is related to a second dimension measured on a second drawing depicting features at a second scaling ratio, comprising a third set of indicia (44, 46, 58, 60) comprising marks spaced at intervals correlating to the second scaling ratio and depicting a second defined number of feet, said third set of marks located on the second side of the tape (Figs. 3-5, Col 4, lines 4-40).

Cook teaches the tape measuring device comprising a housing (12) in which the tape is stored (Fig. 1).

Cook teaches the tape measuring device wherein the third set of indicia include numerals shown next to each mark denoting the number of feet at the distance of each mark with respect to the second scaling ratio (Fig. 5).

Cook teaches the measuring device wherein the second and third set of indicia have a starting point adjacent to each other (Figs. 3-5, Col 4, lines 4-40).

Cook teaches the tape measuring device wherein the first scaling ratio corresponds to one of an engineering and architectural scale (Figs. 3-5, Col 4, lines 4-40).

Cook teaches a tape measurement device for determining a size of a feature on a building plan, the device comprising: a tape (18, 20) having a first side and a second side, each side having a first and a second edge (Figs. 1-5); a first set of regularly spaced marks (22) along a first edge of the first side, the marks denoting fractions of and whole inches, and usable for laying out dimensions of building material for building according to the building plan (Fig. 1, Col 3, lines 43-54); a second set of regularly spaced marks (44, 46, 58, 60) located on a first edge of the second side of the tape, the marks including indicia at regular intervals of marks, said

indicia relate the second marks to the first marks by a scale ratio and depict a defined number of feet (Figs. 3-5, Col 4, lines 4-40), wherein said scale ratio on said plans and measurement of the feature on said building plan using said second set of marks indicates a dimension of said feature to be built using said first set of marks (Figs. 3-5, Col 4, lines 4-19), said first and second set of marks start at a common end of the tape (Col 3, lines 55-60, the appliqué is positioned against or proximal to the end hook 24, which is a common end of the first set of indicia on surface 32).

Response to Arguments

3. Applicant's arguments filed August 24, 2007 have been fully considered but they are not persuasive.

Regarding Applicant's arguments that the Cook appliqué is not coordinated with the end of the tape, such that the inch measurement on the first side corresponds directly to the scaled distances on the second side, Examiner disagrees. Applicant's claim language requires that "the first set of indicia and the second set of indicia start at a common end," in claim 13, and "said first and second set of marks start at a common end of the tape," in claim 31. Cook discloses that the first and second set of indicia/marks start at a common end, the distal portion of the tape, and further states that the appliqué can be positioned against the end hook 24, which is the start of the first set of indicia (Col 3, lines 55-60). The common end, therefore, is the distal end of the tape, which is where both the first and second of indicia/marks begin.

4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the inch measurement on the first side corresponds directly to the scaled distances on the second side) are

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not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims only require that the first and second set begin at a common end.

5. The Affidavit under 37 CFR 1.132 filed August 24, 2007 has been considered. The affidavit was presented in response to the 103(a) rejection of Horning in view of Simmons. Since the amendment to the claims overcomes the rejection of Horning in view of Simmons, the affidavit is moot. It is noted, however, that the affidavit is directed to a long felt need while the rejection of Horning in view of Simmons was directed to modifying a measuring device in the form of a ruler of Horning to a measuring tape, as taught by Simmons, since Simmons discloses that a flat ruler and a tape measure are different but equivalent means of providing indicia for measuring objects (Simmons, Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R. Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARC
September 17, 2007


Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800